

Remarks

Favorable reconsideration of this application is requested in view of the following remarks. For the reasons set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The final Office Action dated July 23, 2004, indicated that claim 23 would be allowable if rewritten in independent form including all limitations of the base claim and intervening claims; claims 1-9, 13, 14 and 20 are rejected under 35 U.S.C. § 103(a) over *Edholm* (U.S. Patent No. 6,449,269) in view of teaching in the art; claim 10 is rejected under 35 U.S.C. § 103(a) over *Edholm* and teaching in the art and further in view of *Bertin* (U.S. Patent No. 6,097,243); claim 11 is rejected under 35 U.S.C. § 103(a) over *Edholm* and teaching in the art and further in view of *Mason* (U.S. Patent No. 6,272,451); claims 12 and 15-18 are rejected under 35 U.S.C. § 103(a) over *Edholm* and teaching in the art and further in view of *Maeda* (U.S. Patent No. 5,884,074); claim 19 is rejected under 35 U.S.C. § 103(a) over *Edholm* and teaching in the art and further in view of *Blomley* (U.S. Patent No. 4,608,462); and claims 21-22 are rejected under 35 U.S.C. § 103(a) over *Edholm* and teaching in the art and further in view of *Adelman* (U.S. Patent No. 5,598,362).

Applicant appreciates the Examiner's indication that claim 23 would be allowable. In this regard, claim 23 has been amended to remove its dependency and to include all the limitations in the base and intervening claims from which it depends. Applicant understands that claim 23, as amended, is allowable.

New claims 24 – 28 have been added. Based upon the impropriety of the finality of the Final Office Action as discussed further below, Applicant believes this claim amendment to be appropriate.

Claims 4 and 6 have been amended to address antecedent basis issues. The amendments have not been made in view of any cited art and have not narrowed the scope of the claims.

Applicant submits that the finality of the Final Office Action is improper because the Examiner introduced new prior art in support of the Section 103 rejections. Specifically, the Examiner attempted to add teachings from a multitude of prior art references to the brief mention of an "ASIC" in the primary '269 reference, upon which all claim rejections rely. These prior art references, while not listed in the statement of the rejections, would

apparently be necessarily combined with the primary '269 reference to arrive at the teachings proposed by the Examiner. For example, four references are cited on page 5 of the final Office Action. However, these references were not cited in the statement of rejection, no portion of these references was cited for any specific teaching and no evidence of motivation to combine these references with the '269 reference was asserted or provided. Similarly, the final Office Action made reference to an ASIC chip with a programmable gate array (Longacre) on page 3 and to four new references cited on page 6. In this regard, the finality of the Final Office Action should be withdrawn and this response, with amendments, should be entered and considered.

Before proceeding with the discussion of the merits of the claim rejections, Applicant submits that the Examiner's attempt to correlate the Applicant's discussion of the cited limitations in the '269 reference with an "admission" is improper. Specifically, on page 2 of the Final Office Action, the Examiner suggests that "applicant is admitting that the limitation was cited under Edholm '269's claim 4." No admission was made. Applicant simply acknowledged that the a portion of the '269 reference was cited that includes a claimed limitation directed to components (*i.e.*, finite state machine, memory, packetizer and network interface) "commonly housed in an ASIC." That is, Applicant simply addressed the Examiner's citation of the '269 reference. Applicant maintains that there is no teaching or suggestion, in the '269 reference, of limitations directed to a programmable audio processor chip in the context of the present invention; the '269 reference does not teach or suggest the claimed programmable audio processor chip. Furthermore, Applicant submits that the ASIC in the '269 reference, while claimed, is not necessarily enabled. Therefore, no "admission" is made regarding the ASIC of the '269 reference and any potential relationship to the claimed limitations of the instant invention, or for its apparent functionality claimed in the '269 reference.

Applicant further submits that all of the claim rejections, each of which relies upon the teachings of the primary '269 reference, are improper because the brief citation to the ASIC in the '269 reference does not meet the Section 103 requirement that the reference(s) teach or suggest all of the claimed limitations. Specifically, while the Examiner has pointed to the recitation of an ASIC in claim 4 of the '269 reference, evidence of teaching or suggestion that the ASIC possesses the functionality of the claimed limitations has not been provided. The Examiner must do more than simply cite an asserted "programmable

processor chip” in rejecting claims that are directed to a chip comprising a variety of functions; the rejection must show that the asserted ASIC has the functionality of the programmable processor chip as claimed in the instant invention. In this instance, the rejection failed to show such functionality and the Examiner’s continued recitation to claim 4 of the ‘269 reference is insufficient to make such a showing.

Referring to claim 1 as an example, the claimed programmable processor chip comprises:

- a DSP voice compression device adapted to compress the voice data;
- audio processing circuitry programmed with an audio processing software application for processing the compressed voice data;
- an IP network stack adapted to store and process IP data, the IP data including protocols for processing the compressed voice data via an IP network; and
- a communication stack adapted to store and process communications data, the communications data including audio processing protocols for processing the compressed voice data.

Claim 4 of the ‘269 reference does not teach or suggest all of these limitations as combined with a chip, and the Examiner has failed to show where (in the ‘269 reference or in any other reference) these limitations are taught or suggested. In addition, no portion of the ‘269 reference was cited in addition to claim 4 in support of any functionality for the ASIC. Applicant has reviewed the ‘269 reference and cannot ascertain any further discussion, enabling or otherwise, of an ASIC and its application to the claimed invention. For instance, the rejections fail to show how a DSP voice compression device, audio processing circuitry, an IP network stack and a communication stack are integrated as claimed on a programmable processor chip. The newly-cited references (on page 5 of the final Office Action) are not discussed to show any specific correlation to these and other claimed limitations. Therefore, it is unclear as to how the claimed specific “ASIC” of the ‘269 reference would apply to the claimed limitations discussed above and/or in other claims of the instant invention. The final Office Action thus failed to show teaching or suggestion of all of the limitations in claim 1 of the instant invention and/or of various ones of the other claims as applicable here and as discussed in the previous Office Action Response.

In addition to the above failures of the cited reference(s) to teach or suggest all of the claimed limitations, the Examiner failed to offer any rationale as to how the claimed ASIC of the '269 reference would function as claimed in the instant invention. That is, any asserted modification of the primary '269 reference must have a reasonable likelihood of success in order to maintain a Section 103 rejection. In this instance, the Examiner has not shown how the '269 reference would function as modified and, therefore, has not shown that there is a likelihood of success in modifying the '269 reference.

Applicant further submits that the Examiner's apparent reliance upon inherency-type arguments and/or taking of Official Notice for functions imparted to the ASIC in the '269 reference are improper and unsupported; thus, the claim rejections relying upon these inherent or "Official Notice" type assertions are improper. As discussed above (and in a previous response), the ASIC claimed in the '269 reference is not discussed in the specification of the '269 reference. Further, the ASIC is not indicated in the '269 reference as possessing the functionality of the claimed programmable chip. In an apparent attempt to impart functionality to ASIC of the '269 reference, the Examiner has improperly introduced assertions of inherency and/or "Official Notice." For example, the Examiner stated on page 2 of the final Office Action that the '269 reference mentions an ASIC but that the Examiner (not the '269 reference, or any reference, for that matter) "asserts an ASIC chip within IP telephone as programmable audio processor chip since the components within ASIC are programmed to perform, operate, and process the voice data." Applicant submits that this and other conclusive assertions by the Examiner are insufficient for maintaining a Section 103 rejection, without support in the prior art.

In view of the above, the Examiner has not shown where the claimed limitations would be inherent or, in the event the Examiner is taking "Official Notice," where evidence in support for the assertion lies. Instead, the Examiner has simply pointed to a brief mention of a generic "ASIC" in the '269 reference and imparted functionality upon the ASIC to arrive at the claimed limitations. Therefore, the proposed inherency-type or taken "Official Notice" is improper and the rejections must be removed.

Applicant further submits that the rejections in the final Office Action fail to meet the Section 103 requirement of evidence of motivation for modifying the primary '269 reference. For example, where the Examiner has cited new art (in apparent combination

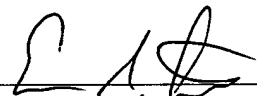
with the primary '269 reference) on page 5 of the final Office Action, asserted "motivation" is that the integration of DSP on a chip "would make the VoIP phone smaller." However, the Examiner has failed to show any evidence of such motivation and further failed to show how the '269 reference would benefit from such a modification.

In view of the above discussion, Applicant believes that the rejections have been overcome and the application is in condition for allowance. A favorable response is requested. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

CRAWFORD MAUNU PLLC
1270 Northland Drive, Suite 390
St. Paul, MN 55120
651/686-6633

Dated: September 23, 2004

By: 
Robert J. Crawford
Reg. No. 32,122
Eric J. Curtin
Reg. No. 47,511